

Appl. No. 09/920,208
Amdt. dated February 28, 2005
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 2644

PATENT

REMARKS/ARGUMENTS

Interview After Final

On February 16, 2005, the Examiner granted two interviews to discuss the finality of the current action. At my prompting, the Examiner presented Applicant's position to a supervisor for a second opinion. No agreement could be reached in these two phone conversations. As any interview after final is discretionary, these opportunities are truly appreciated.

Final Office Action

The Office Action indicates that this is a final Office Action, but Applicant believes a final action is premature. Although the last response did amend the claims, the citing of a completely new reference in a 35 U.S.C. §102 rejection seems inappropriate for a final action. The Applicant cannot imagine how changes to the claims necessitated the change in basis for the rejection from §103 to §102 with a newly found reference. If this new reference were presented before, Applicants would have an opportunity to amend the claims, but now cannot. Applicants respectfully request withdrawal of the final rejection and issuance of a new non-final action.

Specific Teachings from References

The Office Action notes broad swaths of the reference for a particular claim limitation. Specifically, every rejection relies upon Milewski et al., col. 3, line 6 through col. 7, line 21 and figures 3 and 4. Nothing more specific is given for any rejection. In trying to understand the basis for these rejections, many of the particular teachings required by the claims could not be found by the Applicant in the cited columns of the reference.

"In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as

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practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." 37 CFR 1.1.04(c)(2)

The Milewski et al. reference talks about many different embodiments and combinations of the described system. The Applicant cannot discern the basis for the rejection. Applicant respectfully requests identification of the exact passages in the reference that support each limitation for these rejections.

35 U.S.C. §102 Rejection, Milewski et al.

The Office Action has rejected claims 1-16, 19 and 20 under 35 U.S.C. §102(e) as being anticipated by the cited portions of U.S. Patent No. 6,519,326 to Milewski et al. (hereinafter "Milewski"). Although the nature of the rejection cannot be discerned with any specificity, Applicant notes the following limitations that are not taught or suggested in Milewski. More specifically, Milewski cannot be relied on to teach or suggest: (1) "receiving a criterion manually entered by the user before the incoming phone call is placed" as generally required by claims 1 and 9; and (2) "correlating the identifier with a pre-recorded voice announcement using the criterion" as required by claims 1, 9 and 16. Further, the dependent claims provide further ways to distinguish Milewski.

First Missing Limitation: Receiver Entered Criterion Before Receipt

Claims 1 and 9 generally require receiving a criterion from the receiving party before the originating party makes the phone call. This criteria is used when determining the voice announcement to use. Milewski doesn't allow the receiver to enter anything that would affect the message that is sent. Milewski only sends a pre-recorded message or streams one to the receiving party. Milewski, col. 3, lines 18-24. *After* the phone call is placed, the receiver in Milewski can reject the phone call or send it to voicemail. Id., Figure 2. By entering the criteria before the phone call, an embodiment of the claimed invention can affect how the message is played.

Second Missing Limitation: Correlating the Identifier with the Message Using the Criterion

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All claims require correlating the identifier associated with the incoming phone call with a voice announcement using the criteria or selection. Milewski uses IP addressing to send the ring information, then switches to a phone call. *Id.*, col. 4, lines 52-58. Applicants do not understand how the identifier for the incoming phone call could be correlated to a voice announcement sent beforehand in a separate ringing transaction. Further, it is not clear how the criteria or selection is tied into that process.

Patentable Dependent Claims

In addition to the independent claims, the dependent claims provide further basis for patentability. Claims 3 and 11 require correlating the phone number or Caller ID information to the voice announcement. Milewski sends the voice ring announcement using IP protocol, which has nothing to do with a phone number. *Id.*, col. 3, lines 36-46. Claims 6 and 13 require interrupting a phone call to play the pre-recorded voice announcement. Milewski says nothing about interrupting a phone call for another voice ring. Milewski places a normal phone call after the voice ring transaction, but gives no indication that this can be interrupted. *Id.*, col. 4, lines 52-58. Claim 19 allows entry of the criterion or voice announcement with a web interface. Milewski doesn't have such a web interface.

Reconsideration of the rejection is respectfully requested.

CONCLUSION

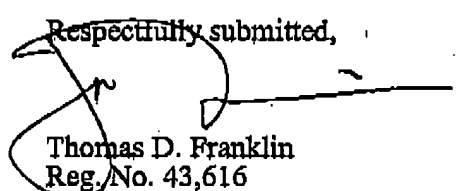
In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is urged. Reconsideration of the claims in their current form is respectfully requested.

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If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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